

## **(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Claims 2-6 stand or fall with independent claim 1. Claims 37-40 stand or fall with independent claim 36.

## **GROUND OF REJECTION NOT ON REVIEW**

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild in view of "Streaming Email", Ellis et al. (6,774,926, of record), and Sezan.

Regarding claim 7, Rothschild discloses a method of sending a video segment and an associated advertisement over a computer network (paragraph 48), comprising:

(a) acquiring a video segment at a computer system (the video portion of a video message, paragraph 48);

(b) selecting, by the sender, an advertisement stored at the server computer system by an advertiser (paragraphs 51-52); and

(c) transmitting from the sender computer to the server computer system an indication of the selected advertisement (paragraph 53).

Rothschild fails to disclose uploading a video segment and a still image in the form of a thumbnail from a sender computer system to the

server computer system, and in response to receiving said indication the server computer system automatically:

- (i) assures that the video segment is in a streaming format;
- (ii) creates an identifier for the video segment, wherein the identifier includes the still image and a link to the video segment;
- (iii) associates the video segment and the advertisement; and
- (iv) sends the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

In an analogous art, Ellis teaches uploading a video segment from a sender computer system to a server computer system (col. 3 line 55 – col. 4 line 4 and col. 7, lines 38-48), allowing smaller entities, such as home users, to create and provide video content (col. 3, lines 19-29).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include uploading a video segment from a sender computer system to the server computer system, as taught by Ellis, for the benefit of allowing smaller entities, such as home users, to create and controllably provide video content, such as personalized, or special interest, content.

Rothschild and Ellis fail to disclose uploading a still image in the form of a thumbnail in response to receiving said indication the server computer system automatically:

- (i) assures that the video segment is in a streaming format;

(ii) creates an identifier for the video segment, wherein the identifier includes the still image and a link to the video segment;

(iii) associates the video segment and the advertisement; and

(iv) sends the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format (i) by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (ii-iv), as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Rothschild, Ellis, and "Streaming Email" fail to disclose acquiring a still image in the form of a thumbnail and the identifier created includes the still image.

Art Unit: 2421

In an analogous art, Sezan teaches generating and associating thumbnail images with a video file in order to assist users in selecting video content for viewing (col. 4 line 40 - col. 5 line 2).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild, Ellis, and "Streaming Email" to include associating a thumbnail image with the video file, as taught by Sezan, for the benefit of assisting users in selecting video content for viewing, as a thumbnail image provides a user with a brief hint or indicator as to the content of the video, and assists a viewer in deciding whether to view the entire file.

Regarding claim 8, Rothschild, Ellis, "Streaming Email", and Sezan disclose the method of claim 7, wherein selecting an advertisement comprises using a criterion chosen by an operator of the sender computer system (Rothschild, paragraph 52).

Regarding claim 9, Rothschild, Ellis, "Streaming Email", and Sezan disclose the method of claim 8, wherein said criterion is a remuneration paid for selected said advertisement (Rothschild, paragraph 49).

Regarding claims 10 and 11, Rothschild, Ellis, "Streaming Email", and Sezan disclose the method of claim 8, wherein said criterion includes leaving said selection to the determination of said server computer system which selects

Art Unit: 2421

the advertisement in a substantially randomized manner (Rothschild, paragraph 52).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild, Ellis, "Streaming Email", and Sezan as applied to claim 10 above, and further in view of Eldering et al. (6,820,277, of record) [Eldering].

Regarding claim 12, Rothschild, Ellis, "Streaming Email", and Sezan disclose the method of claim 10, but fail to disclose said selection is based on a price paid by the advertiser.

In an analogous art, Eldering discloses providing advertisers the opportunity to bid upon advertisement opportunities, awarding the advertisement time slot to the highest bidder (col. 8 line 63 – col. 9 line 12).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild, Ellis, "Streaming Email", and Sezan to select an advertisement based on a price paid by the advertiser, as taught by Eldering, for the benefit of allowing advertisers to bid upon advertisement opportunities, maximizing the advertising revenues generated by the server computer system.

### **(9) Grounds of Rejection**

The following grounds of rejection are applicable to the appealed claims:

Art Unit: 2421

Claims 1-6, and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild (US 2001/0047294 A1, of record) in view of "Streaming Email" (XP-002150023, supplied by applicant) and Sezan et al. (6,236,395, of record) [Sezan].

Regarding claim 1, Rothschild discloses a method of sending a video segment and an associated advertisement over a computer network (paragraph 48), comprising:

(a) acquiring a video segment from a sender at a computer system (the video portion of a video message which is the personal communication, paragraph 48);

(b) acquiring advertisements from advertisers at the computer system (third party, advertiser provided advertisements, paragraph 49);

(c) offering to the sender an opportunity to indicate a selection of an advertisement of the advertisements to be associated with the video segment (pull down menu 404, paragraph 51);

(d) accepting from the sender the indication of a selection of the advertisement to be associated with the video segment (the send message button which indicates the sender has selected the desired advertisement and is ready to send the message, paragraph 53).

Rothschild fails to disclose acquiring a still image in the form of a thumbnail and directly in response to the indication accepted in step (d), automatically at the computer system:

(i) assuring that the video segment is in a streaming format;

(ii) creating an identifier for the video segment, wherein the identifier includes the still image and a link to the video;

(iii) associating the video segment and the advertisement; and

(iv) sending the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format (i) by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (ii-iv), as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Rothschild and "Streaming Email" fail to disclose acquiring a still image in the form of a thumbnail and the identifier created includes the still image.

In an analogous art, Sezan teaches generating and associating thumbnail images with a video file in order to assist users in selecting video content for viewing (col. 4 line 40 - col. 5 line 2).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild and "Streaming Email" to include associating a thumbnail image with the video file, as taught by Sezan, for the benefit of assisting users in selecting video content for viewing, as a thumbnail image provides a user with a brief hint or indicator as to the content of the video, and assists a viewer in deciding whether to view the entire file.

Regarding claim 2, Rothschild, "Streaming Email", and Sezan disclose the method of claim 1, wherein the step of offering to a sender an opportunity to indicate a selection of an advertisement of the advertisements includes a criterion selectable by the sender (via pull down menu 404, Rothschild, paragraph 51).

Regarding claim 3, Rothschild, "Streaming Email", and Sezan disclose the method of claim 2, wherein said criterion is a remuneration paid for selected said advertisement (Rothschild, paragraph 49).

Regarding claims 4-6, Rothschild, "Streaming Email", and Sezan disclose the method of claims 1 and 2, and further disclose the step of offering to a sender



Art Unit: 2421

an opportunity to indicate a selection of an advertisement includes a randomized default selection if the sender fails to indicate a selection (Rothschild, paragraph 52, where if the sender fails to select a particular advertisement, they may select that a randomly selected advertisement be shown).

Regarding claim 36, Rothschild teaches a method for operating a video-sharing server on a network comprising:

storing a plurality of advertisements from advertisers (paragraph 64); and receiving from a client a video, an electronic email address, and a selection of one of the plurality of advertisements (paragraph 57, wherein the email is a video message, paragraph 48).

Rothschild fails to disclose receiving a still image in the form of a thumbnail confirming that the video is in streaming format, storing the video at a network-accessible location, generating an identification tag including a link and the still image to the network accessible location, generating an electronic communication containing the identification tag and addressed to the electronic email address, and transmitting the electronic communication.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313,

Art Unit: 2421

“Video Express Email”), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format, as taught by “Streaming Email” for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Rothschild and “Streaming Email” fail to disclose acquiring a still image in the form of a thumbnail and the identifier created includes the still image.

In an analogous art, Sezan teaches generating and associating thumbnail images with a video file in order to assist users in selecting video content for viewing (col. 4 line 40 - col. 5 line 2).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild and “Streaming Email” to include associating a thumbnail image with the video file, as taught by Sezan, for the benefit of assisting users in selecting video content for viewing, as a thumbnail image provides a user with a brief hint or indicator as to the content of the video, and assists a viewer in deciding whether to view the entire file.

Art Unit: 2421

Regarding claim 37, Rothschild, "Streaming Email", and Sezan disclose the method of claim 36, wherein receiving the video includes receiving an HTTP post (Rothschild teaches the email is assembled and transmitted via interactions with web site 110, paragraph 48).

Regarding claim 38, Rothschild, "Streaming Email", and Sezan disclose the method of claim 36, but fail to disclose publishing the link to a Web page.

Publishing links to videos in web pages is notoriously well known in the art.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method of Rothschild, "Streaming Email", and Sezan to include publishing the link to a Web page.

Regarding claim 39, Rothschild, "Streaming Email", and Sezan disclose the method of claim 36, further comprising receiving a mailing list including a plurality of email addresses and transmitting the electronic message to the plurality of email messages (Rothschild teaches sending a single message to multiple recipients at once, paragraph 53).

Regarding claim 40, Rothschild, "Streaming Email", and Sezan disclose the method of claim 36, wherein the link includes a path ("Streaming Email"

Art Unit: 2421

teachings sending a pointer file which designates the location of the file for streaming, page 308).